

## R E M A R K S

Claims 1, 5, 7, and 11 are amended. Claims 4, 8, 12, and 13 are canceled. Claims 14-16 are withdrawn from consideration as being directed to a non-elected invention. Claims 2, 3, 6, 9, and 10 stand as originally filed. Re-examination and reconsideration are requested.

In the office action, paper number (unspecified), dated January 23, 2007, the examiner acknowledged applicants' prior election without traverse. The examiner rejected claims 1, 4, 7-9, and 11-13 under 35 U.S.C. §102(e) as being anticipated by Goodman, et al., U.S. Patent No. 6,782,448 ("Goodman"). The examiner rejected claims 1-4 and 7-13 under 35 U.S.C. § 103(a) as being obvious over Goodman in view of Chaloner, U.S. Patent Application Publication No. 2002/0138174A1 ("Chaloner '174"). The examiner also rejected claims 1, 4, 7-9, and 11-13 under Section 103(a) as being obvious over Goodman in view of Reasoner, et al., U.S. Patent Application Publication No. 2004/0118215A1 ("Reasoner '215").

The examiner rejected claims 1, 4, 7, and 11-13 under the judicially-created doctrine of double patenting as being unpatentable over claims 1, 6, 8, 9, 12, and 13 of U.S. Patent No. 6,741,907 to Chaloner ("Chaloner '907"). The examiner also rejected claims 1-3 and 5-16 under the judicially-created doctrine of double patenting as being unpatentable over claims 14 (sic, 1, 4), 5, 8, 9, and 13-15 of U.S. Patent No. 6,907,314 to Reasoner et al., ("Reasoner '314").

### Re the Claims:

Claim 1 is amended to include the elements and limitations set forth in the amended claim. Support for the amendments to claim 1 is found throughout the written description and drawings as originally filed and more particularly at, for example, paragraphs 16-20 and Figures 3(a-c) and 4. No new matter is added.

Claim 5 is amended to change its dependency to claim 1.

Claim 7 is amended to include the elements and limitations set forth in the amended claim. Support for the amendments to claim 7 is found throughout the written description and drawings as originally filed and more particularly at, for example, paragraphs 16-20 and Figures 3(a-c) and 4. No new matter is added.

Claim 11 is amended to include the elements and limitations set forth in the amended claim. Support for the amendments to claim 11 is found throughout the written description and drawings as originally filed and more particularly at, for example, paragraphs 16-20 and Figures 3(a-c) and 4. No new matter is added.

Re the Double Patenting Rejections:

The examiner rejected claims 1, 4, 7, and 11-13 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 8, 9, 12, and 13 of U.S. Patent No. 6,741,907. The examiner also rejected claims 1-3 and 5-16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 5, 8, 9, and 13-15 of U.S. Patent No. 6,907,314.

In response, applicants submit herewith two properly-executed terminal disclaimers and the required fees. The terminal disclaimers should remove the obviousness-type double patenting rejections.

Legal Standard For Rejecting Claims  
Under 35 U.S.C. §102 and 103

The standard for lack of novelty, that is, for "anticipation," under 35 U.S.C. §102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81, 90 (Fed. Cir. 1986). Invalidity for anticipation requires that all of the elements and limitations of the claims be found within a single prior art

reference. Scripps Clinic & Research Foundation v. Genentech, Inc., 18 USPQ2d 1001 (Fed. Cir. 1991). Furthermore, functional language, preambles, and language in "whereby," "thereby," and "adapted to" clauses cannot be disregarded. Pac-Tec, Inc. v. Amerace Corp., 14 USPQ2d 1871 (Fed. Cir. 1990).

The test for obviousness under 35 U.S.C. § 103 is whether the claimed invention would have been obvious to those skilled in the art in light of the knowledge made available by the reference or references. In re Donovan, 184 USPQ 414, 420, n. 3 (CCPA 1975). It requires consideration of the entirety of the disclosures of the references. In re Rinehart, 189 USPQ 143, 146 (CCPA 1976). All limitations of the claims must be considered. In re Boe, 184 USPQ 38, 40 (CCPA 1974). In making a determination as to obviousness, the references must be read without benefit of applicants' teachings. In re Meng, 181 USPQ 94, 97 (CCPA 1974). In addition, the propriety of a Section 103 rejection is to be determined by whether the reference teachings appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or other modifications. In re Lintner, 173 USPQ 560, 562 (CCPA 1972).

A basic mandate inherent in Section 103 is that a piecemeal reconstruction of prior art patents shall not be the basis for a holding of obviousness. It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Kamm, 172 USPQ 298, 301-302 (CCPA 1972). Put somewhat differently, the fact that the inventions of the references and of the applicants may be directed to concepts for solving the same problem does not serve as a basis for arbitrarily choosing elements from references to attempt to fashion applicants' claimed invention. In re Donovan, 184 USPQ 414, 420 (CCPA 1975).

A reference which teaches away from the applicants' invention may not properly be used in framing a 35 U.S.C. §103 rejection of applicants' claims. See United States v. Adams, 148 USPQ 429 (1966).

5     Re the Section 102 Rejections:

10     The examiner rejected claims 1, 4, 7-9, and 11-13 under 35 U.S.C. §102(e) as being anticipated by Goodman. These rejections are improper in that Goodman fails to disclose certain limitations contained in all of the pending claims. Because Goodman does not disclose at least these limitations, Goodman cannot anticipate pending claims 1, 7, 9, and 11.

15     Independent claim 1 is directed to an inventory control device that includes "an actuator operatively associated with said latch and said control logic" that is "operable to move said latch from the second position to the first position. . .". That is, and as is described in the specification, the latch is positioned in relation to the access device of the data storage system so that when the access device is opened, the latch moves from the first position to the second position. A sensor detects the position of the latch, i.e., whether the latch is in the first position or the second position. Control logic communicatively coupled to the sensor causes an inventory operation to be conducted if the latch is in the second position and the access device is closed. The inventory control device of amended claim 1 also includes an actuator. The actuator is responsive to the control logic and moves the latch from the second position to the first position.

20     Stated somewhat more briefly, when the access device (e.g., the drawer) is opened, it moves the latch from the first position to the second position. However, when the access device is closed, the latch does not change positions. Instead, the actuator is used to return the latch to the first position.

30     While the Goodman reference discloses a library storage device having a robotic cartridge access device or "picker,"

Goodman fails to disclose an inventory control device that includes all of the elements and limitations set forth in amended claim 1. More specifically, Goodman does not disclose a latch that is moveable between first and second positions, nor does Goodman disclose an actuator for moving the latch from the second position to the first position. Because at least these elements and limitations are not disclosed, or even suggested by Goodman, Goodman cannot anticipate amended claim 1.

Applicants are mindful that in framing his rejections, the examiner asserts that Goodman discloses an actuator (e.g., at col. 11, l. 65 - col. 12, l. 3 of Goodman). See, office action at p. 2. However, the Goodman text refers to a "robot accessor 18," not an actuator. Goodman's robot accessor 18 is another name for a cartridge "picker" assembly and is the device used to move the data cartridges within the library. It is not an actuator within the meaning of the pending claims as it is not operatively associated with a latch. Therefore, because Goodman's robot accessor 18 is not the same as the actuator of pending claim 1, i.e., Goodman's robot accessor is not operatively associated with a latch and cannot operate to move the latch from the second position to the first position, Goodman cannot anticipate amended claim 1.

Moreover, while it is true that Goodman mentions in col. 12, lines 33-35 that a door monitoring switch could "latch" an indicator if a door was opened, thus indicating that an inventory operation should be conducted, nowhere does Goodman provide any additional details of a door monitoring switch, an indicator, or how the door monitoring switch could somehow "latch" the indicator. Indeed, because Goodman uses the word "latch" as a verb to describe how the door monitoring switch interacts with the indicator, it cannot be said that Goodman even discloses a latch (i.e., as a noun).

Even if it were proper (which it is not) to view Goodman's description as disclosing a latch (as a thing as opposed to an action), Goodman does not disclose that such a latch moves

between a first position and a second position, nor does Goodman disclose, or even suggest, an actuator operatively associated with the latch to move the latch from the second position to the first position.

Therefore, because Goodman fails to disclose a latch that is moveable between a first position and a second position, and because Goodman makes no mention of an actuator that is operatively associated with a latch to move the latch from the second position to the first position, Goodman cannot anticipate amended claim 1. Therefore, amended claim 1 is allowable over Goodman.

Dependent claims 2, 3, 5, and 6 are at least allowable over Goodman because they depend from claim 1, which is allowable over Goodman.

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Independent claim 7 is allowable over Goodman because Goodman fails to disclose a method that involves "obtaining a position of a latch," and "operating an actuator to cause the actuator to move the latch from the second position to the first position," as specifically required by amended claim 7.

As described above, it is not reasonable to view Goodman as even disclosing a latch (i.e., as a thing as opposed to an action). However, even if Goodman is viewed as disclosing a latch, Goodman nowhere discloses an actuator that is operatively associated with the latch and that, when actuated, moves the latch from the second position to the first position. While the examiner asserts that Goodman's "robot accessor" 18 is an actuator, it clearly is not within the meaning of claim 7. Goodman's robot accessor 18 is the device that moves the data cartridges within his library, and is clearly indicated as such in Figure 1.

Therefore, amended claim 7 is not anticipated by Goodman because Goodman fails to disclose all of the elements and

limitations contained in amended claim 7.

Claims 9 and 10 are allowable over Goodman at least because they depend from claim 7, which is allowable over Goodman.

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5           Independent claim 11 is not anticipated by Goodman because  
Goodman fails to disclose "latch means" that moves from a first  
position to a second position when the access device is opened.  
Goodman does not disclose a latch. At best, Goodman discloses  
an indicator that is "latched" by a door monitoring switch. Even  
10 if this arrangement is somehow viewed as a "latch means" as  
recited in claim 11, Goodman nowhere mentions the presence of an  
"actuator means," much less an actuator means that is operatively  
associated with the latch means to move the latch means from the  
second position to the first position. Because of these  
15 failures, Goodman cannot anticipate amended claim 11.

Re the Section 103 Rejections:

The examiner rejected claims 1-4 and 7-13 under 35 U.S.C.  
§ 103(a) as being obvious over Goodman in view of Chaloner '174.  
These rejections are improper because even if the references are  
20 combined, the resulting combination would still fail to meet the  
limitations of the pending claims. Consequently, none of the  
pending claims, as amended, are made obvious by Goodman and  
Chaloner '174.

In making his rejections, the examiner recognizes that  
25 Goodman fails to disclose a data storage drawer and asserts that  
Chaloner '174 discloses a data storage drawer. While this is  
true, any combination of Chaloner '174 with Goodman still fails  
to meet the limitations of the amended claims because Goodman  
does not disclose a latch that is moveable between first and  
30 second positions. However, even if it were proper to regard  
Goodman's arrangement as a latch (which is denied), Goodman still  
fails to disclose, or even suggest, an actuator that is

operatively associated with the latch and that can be used to return the latch to the first position from the second position. Because at least these limitations are contained in the pending claims, and are not met by any combination of Goodman and Chaloner '174, none of the claims are rendered obvious by Goodman and Chaloner. That is, amended claims 1-3, 7 and 9-11 are not *prima-facie* obvious over Goodman and Chaloner.

The examiner also rejected claims 1, 4, 7-9, and 11-13 as being obvious over Goodman in view of Reasoner '215. As an initial matter, it appears that the identification of the claims supposedly made obvious by Goodman and Reasoner '215 is erroneous in that they do not include claims 5 and 6. That is, in the body of section 7 of the office action, the examiner appears to also reject claims 5 and 6, even though they are not listed in the first line of section 7. However, the discrepancy is of no consequence because none of the claims are made obvious by Goodman and Reasoner '215.

In framing his rejections, the examiner admits that Goodman does not teach a solenoid as an actuator nor an optical interrupter as a sensor, but that these respective elements are disclosed by Reasoner '215. While it is true that these specific devices are disclosed by Reasoner '215, the examiner has failed to identify any suggestion or incentive in either Goodman or Reasoner '215 that would allow the substitution of such elements. Consequently, the examiner has failed to establish the required *prima-facie* case of obviousness.

Notwithstanding this deficiency, however, even if Goodman and Reasoner '215 were to be combined, the resulting combination would still fail to make obvious any of the pending claims because the resulting combination would still fail to meet all of the elements and limitations of the amended claims. That is, and as set forth above, Goodman does not disclose a latch that is operatively associated with a cartridge access device so that the latch is moved between a first position and a second



position. However, even if Goodman's reference to using a door monitoring switch to "latch" an indicator (col. 12, line 33 of Goodman) is viewed as a latch within the meaning of the pending claims (which is denied), Goodman still fails to disclose an actuator that is operatively associated with the latch and that can be used to move the latch from the second position to the first position. Goodman's "robot accessor" 18 is the device that moves the data cartridges within the library. It is not an actuator within the context of the pending claims. This is, it is not operatively associated with a latch and does not operate to move the latch from the second position to the first position.

Consequently, even if Goodman and Reasoner '215 were combined, the resulting combination would still fail to meet the limitations of the pending claims. Consequently, none of the pending claims are made obvious by Goodman and Reasoner '215.

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Applicants believe that all of the claims pending in this patent application are allowable and that all other issues raised by the examiner have been rectified. Therefore, applicants respectfully request the examiner to reconsider the rejections and to grant an early allowance. If any questions or issues remain to be resolved, the examiner is requested to contact the applicants' attorney at the telephone number listed below.

Respectfully submitted,

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